

E-FILED on 11/14/06

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

MEMRY CORPORATION,

Plaintiff,

v.

KENTUCKY OIL TECHNOLOGY, N.V.;
PETER BESSELINK; MEMORY METALS
HOLLAND, B.V.,

Defendants.

No. C-04-03843 RMW

ORDER OVERRULING KENTUCKY OIL'S
OBJECTION TO PORTION OF
MAGISTRATE JUDGE'S ORDER

[Re Docket Nos. 193, 197, 206, 225]

On September 6, 2006, the magistrate judge assigned to this case ruled on several motions to compel. Kentucky Oil Technology, N.V. ("KOT") objected under Fed.R.Civ.P. 72(a) to two aspects of the magistrate judge's order on these motions. In an order dated September 26, 2006, this court overruled KOT's objection that communications with Wilfried van Moorlegem were protected by the attorney-client privilege, but gave Schlumberger Technology Corporation ("STC") the opportunity to respond to KOT's objection that it should not be required to provide further responses to an interrogatory of STC seeking the dates of reduction to practice.¹


¹ This court also referred to a motion by KOT to augment the record and for reconsideration as "currently pending before the magistrate judge." The court notes that KOT has recently requested a ruling from the magistrate judge on this motion. It would appear from the terminal paragraph of KOT's motion to augment the record and for reconsideration that the motion would be deemed

KOT objects that its counterclaim for patent invalidity has been dismissed, making irrelevant any reduction to practice. However, KOT will have to corroborate Peter Besselink's assertion that he reduced to practice the inventions embodied in the patents held by STC. *See Ethicon, Inc. v. U.S. Surgical Corp.* 135 F.3d 1456, 1461 (Fed. Cir. 1998). The interrogatory is thus directed to information that is potentially relevant to KOT's claim for correction of inventorship, as knowledge of the precise dates of Besselink's alleged reduction to practice would aid in the search for corroborating evidence.² The magistrate judge's order is not contrary to law, and KOT's objection is overruled.

ORDER

For the foregoing reasons, the court overrules KOT's objection regarding the reduction-to-practice interrogatory.

DATED: 11/14/06


 RONALD M. WHYTE
 United States District Judge

withdrawn upon KOT's filing of objections with the district judge. In any event, this court has ruled based upon the record before it and assumes the magistrate judge did not choose to reconsider his ruling or allow augmentation of the record.

² KOT points out that STC did not assert a defense of patent invalidity to KOT's claim for correction of inventorship under 35 U.S.C. § 256. Defects in subject-matter jurisdiction cannot be waived. *See Ins. Corp. of Ir., Ltd. v. Compagnie des Bauxites de Guinee*, 456 U.S. 694, 702 (1982); Fed.R.Civ.P. 12(h)(3).

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 16 **Dated:** 11/14/06

/s/ JH
 Chambers of Judge Whyte